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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/686,063	10/15/2003	Gene P. DiPoto	ENDIUS.027CP1D1	7977
33469 7590 02/20/2009 CROMPTON, SEAGER & TUFTE, LLC 1221 NICOLLET AVENUE SUITE 800 MINNEAPOLIS, MN 55403-2420				
EXAMINER				
BUL VY Q				
ART UNIT		PAPER NUMBER		
3773				
MAIL DATE		DELIVERY MODE		
02/20/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/686,063

Applicant(s)

DIPOTO ET AL.

Examiner

Vy Q. Bui

Art Unit

3773

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 56-110 is/are pending in the application.
- 4a) Of the above claim(s) 74-86 and 107-111 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 56-73 and 87-106 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 56-73, 87-106 are rejected under 35 U.S.C. 102(b) as being anticipated by Kogasaka et al.-EP0807415A2.

As to claims 56-73, 87-106, Kogasaka-'415 (line 33, col. 69 to line 48, col. 70; Figs. 110-112, for example) discloses retractor 401, a trocar as a dilator for an introduction of retractor 401 into a spinal location of a patient, at least five discrete segments 444 radially expanding in a non-linear manner, hollow tube 447 to receive a combination of a feed/suction tube and forceps and inherently a process including steps substantially as recited in the claims.

Notice that the recitations "notches" in the claims 87-98 are interpreted as different steps or degrees of expanding of discrete segments 444, which are controlled by how far the rod/tube 447 is pulled proximally.

Further, the recitations "first blade", "second blade" and "first connector"/"second connector" in claims 107-110 are interpreted as segments 444 and mesh 443.

Response to Arguments

Applicant's arguments filed 9/7/2007 have been fully considered but they are not persuasive.

1. Argument: Kogasaka-'415A does not appear to disclose or suggest a step of "moving a plurality of discrete segments of the retractor away from each other to retract tissue adjacent the spinal location" as recited in each of the independent claims 56, 65, 74, 87 and 99.

Response: it is undeniable that Kogasaka-'415's elastic member 444 made of a spring material are expanded from a configuration shown in Fig. 111A to an enlarged configuration shown in Fig. 111B. When elastic members 444 are expanded to strip tissue, members 444 and mesh 443 must apply a pressure on the tissue and therefore retract/move tissue away from the original position of the tissue. Inherently, there must be a step of retracting/moving the tissue away from the original position of the tissue.

2. Argument: Independent claim 65 further recites, "pivoting the distal portion relative to the proximal portion." Kogasaka et al. do not appear to teach or suggest this.

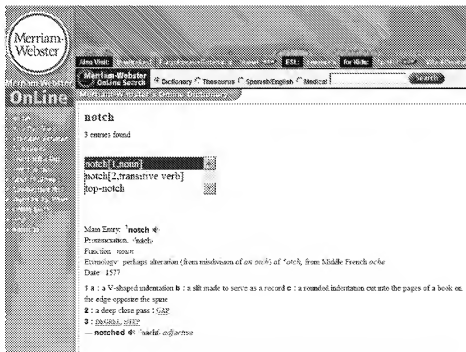
Response: an enlarged configuration in Fig. 111B shows distal portion spring members 444 pivoting about proximal portion located at ring 445.

3. Argument: Independent claim 87 further recites, in part, "wherein the discrete segments are moved away from each other by being guided incrementally along successive notches of a guiding mechanism." Claim 96 recites, "wherein each of said notches maintains a desired configuration of said retractor," claim 97 recites, "wherein each of said notches prevents the retractor from moving from an expanded configuration to a contracted configuration," and claim 98 recites, wherein the guiding mechanism comprises at least three notches." Kogasaka et al. do not appear to teach or suggest these. The Examiner asserts that "notches" are

Art Unit: 3773

interpreted as different steps or degrees of expanding of discrete segments 444. Applicants respectfully disagree. Kogasaka et al. do not appear to teach or suggest notches or a guiding mechanism, other than the tube 447, which does not appear to have notches or any other structure that would be expected to allow the segments 444 to move away from each other incrementally. The Examiner has not provided any reasoning for the interpretation of "notches of a guiding mechanism" on the structure of Kogasaka et al. Further, the Examiner has not provided any reasoning for why one of ordinary skill in the art would interpret the method steps of Kogasaka et al. as including the claimed method step. Kogasaka et al. thus do not appear to teach the identical method steps in the same detail as is recited in claims 87 and 96-98.

Response: a notch, by definition, can be broadly understood as a step, a degree (see definition 3 of "notch" copied and shown on next page, Merriam-Webster Dictionary). Spring member 444 and mesh 443 expand step by step when handling rod 447 is pulled proximally. Each "pulling step" defines a notch as recited in the claims.



Conclusion

The Final Rejection has been withdrawn. This is a non-final rejection for beginning of the reopening of prosecution for Applicant reconsideration.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vy Q. Bui whose telephone number is 571-272-4692. The examiner can normally be reached on Monday-Tuesday and Thursday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jackie Ho can be reached on 571-272-4696. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Vy Q. Bui/

Primary Examiner, Art Unit 3773